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EXAMINER	
KHAN, ASHER R	

ART UNIT	PAPER NUMBER
2621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/803,987	FRIEDMAN, ANDREW	
	Examiner	Art Unit	
	ASHER KHAN	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

> Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.
>
> When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).
>
> In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

2. **Claim 15 and 16** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 17 is drawn to functional descriptive material recorded on a computer readable medium. Normally, the claim would be statutory. However, the specification, at page 3 paragraph 49 defines the claimed computer readable medium as encompassing statutory media such as a

"ROM", "hard drive", "optical drive", etc, as well as ***non-statutory*** subject mater such as a "signal" .

> A "signal" embodying functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory classes of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 13, 15, 16, 17 and 18 are rejected under 35 U.S.C. 102(b) as being unpatentable over U.S. Patent Pub. 2003/0026592 A1 to Kawahara et al. "Kawahara".

As to claims 1, 15, 16 and 17, Kawahara discloses a method of generating a dependent media track that is loosely synchronised to a source media track, the dependent media track comprising a sequence of dependent media items, said method comprising the steps of:

arranging, in an order, a sequence of Edit Decision List (EDL) (0017; Edit decision list) elements (Fig. 5, 4-1,5-1……) for a corresponding sequence of media items (Fig. 3, the Hatched part of Source material) in the source media track, wherein at least an ordered

sub-set (Fig. 5)of the sequence of EDL elements contain track control attributes (timecodes;0114) for corresponding dependent media items(Fig. 3, Title, Main-part CU1, Recollection scene, Main-Part CU2) in the dependent media track(Fig. 3, Edit-Result material ED); and

generating the dependent media track (Fig. 3, Edit-Result Material ED) dependent upon at least some of said track control attributes (timecodes;0114) and the order in which the sub-set of EDL elements(Fig. 5, 4-1,5-1……) is arranged (Fig. 3),

wherein at least one dependent media item in the dependent track is dependent upon a track control attribute (timecodes;0114) in an EDL element (Fig. 5, 4-1, 5-1...) in the neighborhood of the corresponding EDL elements in the sub-set (Fig. 5; Also sub-set can also be considered as one editing unit function illustrated in Fig.9, or one of the figures from).

As to claim 4, Kawahara further discloses wherein commencement of the dependent media track (Fig. 3, Edit-Result material ED) is dependent upon a track control attribute (timecodes;0114) associated with an EDL element in the sub-set (Fig. 5) of the EDL elements (Fig. 5, 4-1,5-1……).

As to claim 5, Kawahara further discloses where in commencement of the dependent media track (Fig. 3, Edit-result material Ed) is dependent upon a track control attribute (time codes;0114) associated with an EDL element (Fig. 5, 4-1,5-1……) which is positioned in the sequence of EDL elements prior to a first EDL element in the ordered sub-set of the EDL elements (Time codes are old time code mentioned in source, Fig.3).

As to claim 6,Kawahara further discloses wherein termination of the dependent media track (Fig. 10, Log Material) is dependent upon a track control attribute (Time codes) associated with an EDL element in the sub-set of the EDL elements (Fig. 11).

As to claim 7, Kawahara further discloses wherein termination of the dependent media track is dependent upon a track control attribute associated with an EDL element which is positioned in the sequence of EDL elements subsequent to a final EDL element in the sub-set of the EDL elements (Fig. 11, E4 is dependent on E5).

As to claim 12, Kawahara further discloses, wherein a said track control attribute comprises one of an attribute to activate (Fig. 5, time code to start i.e. 00:05.00) a dependent media item in the dependent media track and an attribute to deactivate (Fig. 5, time code to stop i.e. 00:25.00) the dependent media item in the dependent media track (Fig. 5).

5. Claims 2, 3 and 14 are rejected under 35 U.S.C. 102(b) as being unpatentable over U.S. Patent Pub. 2003/0026592 A1 to Kawahara et al. "Kawahara" in view of Official Notice.

As to claims, 2, 3 and 14, Kawahara does not expressly disclose re-ordering the sub-set of EDL elements, re-generating the dependent media track dependent upon at least some of said track control attributes and the order in which the sub-set of EDL elements is re-ordered and deletion of one of the sub-set of the EDL elements. However Official Notice is taken of the fact that it is very well known in to re-ordering and deletion of the sub-set of EDL elements and regenerating dependent media track. Therefore taking the combined teaching of Kawahara and Official Notice, it would have been

obvious to one skilled in the art at the time of the invention to have been motivated to have the features claimed so that an Editor can change his or her previous EDL list if he does not like the previously arranged EDL.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. 2003/0026592 A1 to Kawahara et al. "Kawahara" in view of U.S. Patent 5,801,685 to Miller et al "Miller".

As to claim 8, Kawahara as discussed in claim 1 above does not expressly disclose wherein the dependent media track is a graphical overlay that is copied from a template which is referenced by one of said track control elements.

Miller discloses wherein the dependent media track(Text Script) is a graphical overlay (Fig. 3) that is copied from a template which is referenced by one of said track control elements (control characters)(Col 3 lines 38-67; Col 4 lines 1- 52)(Fig. 3)(Col. 1 lines 10-67; Col 2 lines 1-20).

At the time of invention it would have been obvious to a person of ordinary skill in the art to combine Kawahara with the teaching of Miller. Rationale to have combined would be that all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in

their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention.

As to claim 9, Kawahara as discussed in claim 1 above does not expressly discloses wherein the copy of the template is transformed to thereby form the dependent media item.

Miller further discloses wherein the copy of the template is transformed to thereby form the dependent media track (Text Script) (Col 3 lines 38-67; Col 4 lines 1-52)(Fig. 3) (Col. 1 lines 10-67; Col 2 lines 1-20).

At the time of invention it would have been obvious to a person of ordinary skill in the art to combine Kawahara with the teaching of Miller. Rationale to have combined would be that all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention.

As to claim 10, Kawahara as discussed in claim 1 above does not expressly discloses wherein a said media item in the source track comprises a copy of a media item which is referenced by a corresponding said EDL element in the sequence.

Miller further discloses wherein a said media item (video Clip) in the source track comprises a copy of a media item which is referenced by a corresponding said EDL element (Start time of the clip) in the sequence (Col 3 lines 38-67; Col 4 lines 1- 52)(Fig. 3) (Col. 1 lines 10-67; Col 2 lines 1-20).

At the time of invention it would have been obvious to a person of ordinary skill in the art to combine Kawahara with the teaching of Miller. Rationale to have combined would be that all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention.

As to claim 11, Kawahara as discussed in claim 1 above does not expressly discloses wherein the copy of the media item is transformed to thereby form the media item in the source track.

Miller further discloses wherein the copy of the media item is transformed to thereby form the media item in the source track (Col 3 lines 38-67; Col 4 lines 1-52)(Fig. 3) (Col. 1 lines 10-67; Col 2 lines 1-20).

At the time of invention it would have been obvious to a person of ordinary skill in the art to combine Kawahara with the teaching of Miller. Rationale to have combined would be that all claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks- Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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